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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,624	09/26/2003	Richard H. Selinfreund	VTI-107.1B(US)	8082
909	7590	11/16/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			FRANKLIN, JAMARA ALZAIDA	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			2876	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/672,624	Applicant(s) SELINFREUND ET AL.	
	Examiner Jamara A. Franklin	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Acknowledgment is made of the amendment filed on 9/30/05. Claims 1 and 4-15 are currently pending.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Narusawa et al. (US 6,527,173) (hereinafter referred to as 'Narusawa').

Narusawa teaches an IC card (crude card 26) and method for authenticating the IC card comprising a substrate, said substrate having a semiconductor integrated circuit (IC module 53) and one or more deformable or deformation-derived optical data (data in the computer generated holograms (CGHs)) incorporated therein that are representative of digital data (col. 5, line 59- col. 6, line 3);

the IC card wherein one or more of said optical deformations are associated with an optical state change security material (metal layer 36);

the IC card wherein the optical state change security material is a transient optical state change security material;

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the IC card wherein the transient optical state change material is associated with the optical data deformations in such a manner as to provide at least two optical data reads when the optical data deformations are read by an optical reader (col. 10, lines 5-6);

the IC card wherein one optical data read is indicative of valid data, while the other optical data read is indicative of invalid data;

the IC card wherein the deformable or deformation-derived optical data comprise pits and lands (see figures 3(b)-3(e)); and

the method of determining the locations where which transient optical state change materials are located on the authentic IC card (col. 8, lines 36-42);

the method wherein the optical data change is transient as the optical state security change material reverts back from an optical state to an initial state within a time interval; and

the method wherein the time interval between optical states may be predetermined.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narusawa in view of Setani (US 4,963,464).

The teachings of Narusawa have been discussed above.

Narusawa lacks the teaching of pits comprising two distinctly different depths.

Setani teaches an IC card comprising a substrate having one or more optical data deformations wherein pits of the optical deformations comprise two distinctly different depths (see figures 5 and 8).

One of ordinary skill in the art would have readily recognized that providing the invention of Narusawa with pits having two distinctly different depths would have been beneficial for increasing the amount of data incorporated into the card. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the teachings of Narusawa with the aforementioned teaching of Setani to expand the card's storage capabilities.

#### ***Response to Arguments***

6. Applicant's arguments filed 9/30/05 have been fully considered but they are not persuasive.

In response to the argument that the Narusawa invention does not disclose deformable or deformation-derived optical data, the examiner submits that the Narusawa invention teaches one or more deformable optical data since the holograms, by nature, are visually deformable representations of visual data.

In response to the argument that the alleged combination of the reference does not reasonably predict the presently claimed invention namely because the references do not disclose or suggest distinct transient optical state changes with deformable optical data, the examiner submits that optical state changes take place within the card of the Narusawa invention when the card, and therefore, the hologram is moved relative to the user's visual perspective. Such is the inherent characteristic of a hologram.

In response to the argument that the references are silent as to the inventive use of a transient optical state change security material so as to achieve a barrier to illegal or inadvertent IC card access or use, the examiner submits that such limitations are not claimed in the instant application. Furthermore, such a limitation would be considered a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

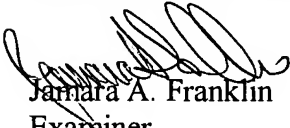
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamara A. Franklin  
Examiner  
Art Unit 2876

JAF  
November 3, 2005



MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
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